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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,929	09/04/2003	Chun-Hee Song	Q75250	4912

23373 7590 09/12/2007

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EXAMINER	
VETTER, DANIEL	
ART UNIT	**PAPER NUMBER**
3628	

MAIL DATE	DELIVERY MODE
09/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/653,929	SONG, CHUN-HEE	
	Examiner	Art Unit	
	Daniel P. Vetter	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-17 were previously pending in this application. Claims 1, 3, and 9 were amended and claims 4-8 and 11-17 were cancelled in the reply filed July 3, 2007. Claims 1-3 and 9-10 are currently pending in this application.

Response to Arguments

2. Applicant's arguments filed July 3, 2007 have been fully considered but they are not persuasive.

3. Applicant argues on page 6 of the remarks that the teachings of Yap are deficient because Yap "store[s] the recorded events and information together." As a threshold matter, Yap teaches the presence of multiple storage units but does not explicitly state that additional information and programs are necessarily stored together. Moreover, a claimed invention that differs from the prior art only in terms of its ability to separate is prima facie obvious in the absence of a new and unexpected result. See *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (invention that is met by the prior art but for its ability to separate held to be obvious where it is considered desirable for any reason to obtain separate access to the separable portion). Finally, applicant concedes that Agnihotri stores additional program information separately from the actual program (page 6 of the remarks, second paragraph) and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4. Applicant further argues on page 6 of the remarks that the teachings of Agnihotri are deficient because "Agnihotri discloses recording entire transcripts of programs" rather than title and summary information. This argument is unpersuasive because Yap teaches title and summary information at least at ¶ 0131 and one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. Moreover, Agnihotri explicitly teaches storing at least title information in ¶ 0061.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yap, et al., U.S. Pat. Pub. No. 2001/0033736 (Reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri, et al., U.S. Pat. Pub. No. 2002/0081090 (Reference B of the PTO-892 part of paper no. 20070322).

7. As per claim 1, Yap, et al. teaches a method of preventing a duplicate recording of a broadcasting program, comprising: extracting additional information from a digital broadcasting program (¶ 0131) and recording the additional information in an additional storage unit (¶ 0133), the additional information including title and summary information (¶ 0131); before entering a recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit (¶ 0131); searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program (¶ 0133); if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, comparing summary information included in the read additional information with that stored in the recording unit in connection with the detected title information (¶ 0134); and entering the recording mode to enable

recording of the to-be-recorded broadcasting program on the recording unit (¶ 0139). Yap, et al. does not explicitly state that the additional information is recorded separately; which is taught by Agnihotri, et al. (¶ 0053). It would have been prima facie obvious at the time of invention to separate the additional information because a claimed invention that differs from the prior art only in terms of its ability to separate is prima facie obvious if it merely yields a predictable result. *Dulberg*, 289 F.2d at 523. Yap, et al. does not teach calculating a correspondence ratio; comparing the calculated correspondence ratio with a predetermined reference value, and if the correspondence ratio is less than the predetermined reference value, entering the recording mode to enable recording of the to-be-recorded broadcasting program on the recording unit. Agnihotri, et al. teaches calculating a correspondence ratio (¶ 0058); comparing the calculated correspondence ratio with a predetermined reference value (¶ 0060), and if the correspondence ratio is less than the predetermined reference value, recording of the program on the recording unit (¶ 0063). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Agnihotri, et al. into the method taught by Yap, et al. in order to match already-recorded programs (as taught by Agnihotri, et al., ¶ 0057). Agnihotri, et al. teaches that the comparison occurs after recording has already begun rather than the comparison occurs before recording; however Yap, et al. teaches the comparison occurring before recording begins (¶ 0133).

8. As per claim 2, Yap, et al. in view of Agnihotri, et al. teaches the method of claim 1 as described above. Yap, et al. further teaches the title information includes sub-title information (¶ 0131).

9. As per claim 3, Yap, et al. in view of Agnihotri, et al. teaches the method of claim 1 as described above. Yap, et al. further teaches producing a message informing that there is a broadcasting program already recorded in the recording unit, which broadcasting program may be identical to the to-be-recorded broadcasting program (¶ 0133). Agnihotri, et al. further teaches determining whether or not to take action if the correspondence ratio is greater than the predetermined reference value (¶ 0060). It

would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Agnihotri, et al. into the method taught by Yap, et al. in view of Agnihotri, et al. because using a correspondence ratio is one way to determine if a program has already been recorded (as taught by Agnihotri, et al., ¶¶ 0055-58).

10. As per claim 9, Yap, et al. teaches a method of preventing duplicate recording of a broadcasting program, comprising: extracting additional information from a digital broadcasting program (¶ 0131) and recording the additional information in an additional storage unit (¶ 0133), the additional information including title and summary information (¶ 0131); before executing a recording command, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit (¶ 0131); searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program (¶ 0133); and if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, halting the recording (¶ 0135). Yap, et al. does not explicitly state that the additional information is recorded separately; which is taught by Agnihotri, et al. (¶ 0053). It would have been prima facie obvious at the time of invention to separate the additional information because a claimed invention that differs from the prior art only in terms of its ability to separate is prima facie obvious if it merely yields a predictable result. *Dulberg*, 289 F.2d at 523. Yap, et al. does not explicitly teach that the halting of the recording is done by ignoring the recording command; which is taught by Agnihotri, et al. (¶ 0062). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Agnihotri, et al. into the method taught by Yap, et al. in order to prevent re-recording of the same program (as taught by Agnihotri, et al., ¶ 0017).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yap, et al. in view of Agnihotri, et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Pat. No. 6,854,127 (Reference C of the PTO-892 part of paper no. 20070322).

12. As per claim 10, Yap, et al. in view of Agnihotri, et al. teaches the method of claim 9 as described above. Yap, et al. in view of Agnihotri, et al. does not teach the title information includes information on a sequence number of the to-be-recorded broadcasting program; which is taught by Kanemitsu (column 5, lines 54-61). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Kanemitsu into the method taught by Yap, et al. in view of Agnihotri, et al. because sequence information is used to identify specific content (as taught by Kanemitsu, column 2, lines 50-53).

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER